

REMARKS:

I) Claims 1- 7, 11, 17- 18 and 22- 31 stand rejected under 35 USC 103(a) as being anticipated by Tichenor (US 4,187,534). As the Examiner's remarks prior to this rejection recited that the basis for an "obviousness" rejection is 35 USC 102, it is being presumed that page 2 of the Examiner's remarks contains two typographical errors and the claims 1-7, 11, 17- 18 and 22- 31 are actually rejected under 35 USC §102(a) as anticipated by Tichenor.

"Anticipation" means that the claimed invention was previously known, and that all of the elements and limitations of the claim are described in a single prior art reference. *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F2d 1471, 1479 (Fed Cir. 1986). Under 35 USC §102, anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *Hakim v. Cannon Avent Group, PLC*, 2005-1398 (Fed. Cir. 2007). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) MPEP 2131. Moreover, an anticipation reference must be shown in as complete detail as is recited in the claims. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989) MPEP 2131. Additionally, for anticipation, the elements shown in a reference must be arranged as required the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Identity of elements, and not identity of terminology is required, thus there is not *ipsissima verbis* test. MPEP 2131.

Several of the claims are being amended for either: an antecedence issue; or for a proper Markush statement; or for grammar; or to eliminate redundancy upon other amendments.

Independent claims 1 and 22 are also being amended to distinguish over the cited prior art.

II) Claims 1 and 19- 21 stand rejected under 35 USC §103(a) as being obvious in view of Tichenor.

The existing law on "obviousness" under 35 USC §103(a) is well known, however, several precepts bear repeating.

The claims of an application are to be interpreted in light of the specification and drawings. *Markman v. Westview Instruments, Inc.*, 116 S Ct 1384 (1996). While pending claims *must be given* the broadest reasonable interpretation consistent with the disclosure, see MPEP §2111 and also *Phillips v. AWH Corp.*, 75 USPQ2d 1321 (Fed. Cir. 2005), the Examiner is constrained in claim interpretation to the interpretation given by the applicant.

Where, either in the specification or during prosecution, a definition or explanation of a term is provided by the applicant, that definition or explanation will control the interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries, Inc.*, 199 F.3d 1295, 53 USPQ2d 1065 (Fed. Cir. 1999); *Hormone Research Foundation Inc. v. Genentech Inc.*, 904 F.2d 1558, 15 USPQ2d 1039 (Fed. Cir. 1990). Moreover, an applicant is to be permitted some latitude in the manner of expression and aptness of terms used in claiming, even though the claim language is not as precise as the examiner might desire.

See MPEP §2173.02; *Solomon v. Kimberly-Clark Corp.*, 55 USPQ2d 1279 (Fed. Cir. 2000).

In order to support an obviousness rejection under §103(a), an Examiner is required to set forth in his Office Action: *an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.*

See MPEP 706.02(j). If the Examiner has failed to adequately meet this test, a standing rejection under §103(a) is without proper foundation.

Additionally, to establish a *prima facie* case of obviousness the following three basic criteria must be met:

1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to combine the specific reference(s) teachings;

- 2) there must be a reasonable expectation of success in combining the specific reference(s) teachings; and
- 3) the prior reference (or references when combined) must teach or suggest all of the claim limitations. See MPEP 706.02.

Without all three, an obviousness rejection under §103 cannot be sustained.

Moreover, it is well settled law that teachings or a suggestion to combine, and the reasonable expectation of success, must both be found in the prior art and not based upon the applicant's disclosure, or any "hindsight" argument raised by the Examiner. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed Cir 1991); MPEP 2143 - 2143.03; *Ex parte Clapp*, 277 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

The amended claims presented herein likewise distinguish the present invention, recited in claims 1 and 19- 21, as unobvious over Tichenor.

III) Claims 1, 8- 10, 22, 24- 26 and 32 stand rejected under 35 USC §103(a) as being obvious in view of Tichenor.

The amended claims presented herein also distinguish the present invention, recited by claims 1, 8- 10, 22, 24- 26 and 32, as unobvious over Tichenor.

IV) The present amendments are supported by the disclosure recited in original claim 5, and in the specification at page 3, lines 24- 30.

The present Invention Is directed to a support element for an optical modifier for e.g. coupling in and out signals of individual or a plurality of wavelength channels into or out of wave guides with such a support element (where the wave guides may be a part of a fibre optic communications system). Although not explicitly recited in claim 1, at least one of the wave-modifying elements should be able to distinguish between different wavelength channels, in order to treat them differently.

Therefore, according to claim 1 as now amended, one supporting surface has at least two openings. According to the invention, the openings of the individual supporting surfaces are arranged in a mutually displaced relationship so that this affords a zigzag-shaped beam path.

In contrast, Tichenor et al. discloses merely a lens housing providing a series of grooves for the selective mounting of various lenses to achieve various beam spreads. This lens housing is used in theatrical stage luminaires or In spotlights to influence the beam spread characteristics. The Tichenor lens housing has a pair of ventilation slots 60 between the inner lens 32 and groove 3 and another pair of elongated openings 62) for ventilation and located between grooves 3 and 4, Figs 2, col. 3, lines 54- 59. These vent slots perform no optical function at all. They are necessary because the stage lamp 20 creates a lot of heat in the small enclosure of the Tichenor spotlight housing.

In hindsight, in view of applicant's claim language, the Examiner is attempting to force the Tichenor structure into the language of applicant's claims. The Tichenor disclosure is in a totally different technical field for which the Tichenor structure being taught is not transferable into the wave guide/fibre optic transmission field. Therefore, one of ordinary skill in the optics art would not identify corresponding supporting surfaces in the Tichenor spotlight housing for holding applicant's wave-modifying elements, which wave-modifying elements must be arranged in mutually parallel relationship as required by applicant's claims. It seems that the examiner is trying to identify the walls of the grooves of the Tichenor spotlight housing as supporting surfaces, since these grooves are intended to clamp a Tichenor lens. But even if one would regard one of side walls of the grooves of the Tichenor spotlight housing as a supporting surface, none of the supporting surfaces can be regarded as a supporting surface with at least two openings. The Tichenor elongate ventilation opeinings 60, 62 cannot be positioned in his lens supporting grooves 1, 2, 3, or 4, as a lens would then block the ventilation openings and thereby defeat there purpose. One of ordinary skill in the art would not do or think as the Examiner is hypothesizing.

Moreover, the embodiment shown and disclosed by Tichenor cannot be regarded as a multiplexer/demultiplexer as there is no hint to replace one or more of the lenses mounted Tichenor spotlight by a mirror or a band pass filter, since the shown lens systems would not work with a mirror and the use of a band pass filter would introduce a drawback, since the luminosity of the lighting will be reduced.

Even more, a zigzag-shaped beam path is neither disclosed nor suggested by Tichenor and, of course, a zig-zag is not necessary to influence the beam spread characteristics of the Tichenor spotlight.

V) Conclusion: For a person skilled in the art, there is no statement nor suggestion, nor a hint to amend the Tichenor sport light housing in order to provide a supporting surface with on or more than one openings in the supporting surface as required by applicant's claims. For all of the above reasons, the standing §102(a) [sic] and §103(a) rejections must now be withdrawn.

It is requested that the application now be re-examined and passed to issue with the amended claims presented herein above.

No additional fees are believed to be required. In the event that an additional fee is required with respect to this communication, the Commissioner is hereby authorized to charge any additional fees, or credit any overpayment, to Paul & Paul Deposit Account No. 16-0750. (order no. 7643)

Respectfully submitted,  
Paul & Paul

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